

REMARKS

Claims 21 - 27 have been added. Claims 1 - 27 are presently pending in this application. Reconsideration and allowance of all pending claims are respectfully requested in view of the following remarks.

I. Preliminary Matters

The Examiner has kindly acknowledged the claim for foreign priority, as well as receipt of the certified copy of the priority document.

The Examiner has also returned an initialed copy of (substitute) Form PTO-1449 thereby indicating the Examiner has considered the references cited thereon.

Claims 1, 8 - 18 and 20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over EP 854 045 A2 (Childers et al., hereinafter "Childers") in view of US 2002/0015066 (Siwinski et al., hereinafter "Siwinski"). Claims 2 and 18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Childers in view of Siwinski and further in view of US 5,950,403 (Yamaguchi et al., hereinafter "Yamaguchi"). For the reasons that follow, these rejections are respectfully traversed.

The Examiner has objected to claims 3 - 7 and 19 on the basis of being dependent upon rejected base claims 1 and 17, respectively. The Examiner further asserts that claims 3 - 7 and

19 would be allowable if rewritten in independent form including all the limitations of the base claim and any intervening claims.¹ (Office Action dated 08-29-02 at 5.)

Applicants have amended claims 8, 12 and 19 to correct grammatical errors and for precision of claim language. Applicants respectfully submit that the amendments to claims 8, 12 and 19 do not narrow the scope of the claims, but are made purely for precision of claim language and to correct grammatical errors, and, as such, do not give rise to *Festo* estoppel.

II. Rejection under 35 U.S.C. § 103(a) over Childers and Siwinski

Claims 1, 8 - 18 and 20 have been rejected under 35 U.S.C. § 103 as being unpatentable over Childers and Siwinski.

Initially, assuming *arguendo* that Childers could somehow be combined with Siwinski, the resultant combination would lose its desired functionality if actually combined. By way of explanation, Childers teaches a flexible ink bag 14 installed in a hard-bodied chassis 16 (referencing Figure 3). Further, Siwinski teaches transponders 54a-d fixedly connected to hard-bodied reservoirs 14a-d (referencing Figure 1).

¹ Specifically in regards to claim 19, while not mentioned in the detailed comments to the Office Action, claim 19 is listed in the Office Action Summary as objected to, but is not addressed in the Office Action. In a telephonic conversation on 09-16-02, the Examiner articulated her intent was to state that claim 19 was objected to but would appear to be allowable if rewritten in independent form to include all limitations of the base claim 17 and intervening claim 18. (Telephonic conversation 09-16-02 between Examiner and patent agent J. Beckstead (registration no. 48,232).)

Combining Childers with Siwinski would thus result in a removable ink bag installed in a hard-bodied ink reservoir with a transponder connected to the ink reservoir. In such a configuration, the ink bag could be removed or replaced, the effect being separation of the memory chip from the ink bag. As such, any newly installed “rogue” bag containing an unknown quantity of ink would cause the transponder to have incorrect data as to the actual level or type of ink installed. Because of this, combining Childers with Siwinski would result in the non-functionality of Siwinski’s stated purpose. As such, the combination is improper. *See* MPEP §§ 2143.01; 2145. *See also In re Gordon*, 221 USPQ 1125 (Fed. Cir. 1984) (reversing an obviousness determination because the modification would have rendered the prior art apparatus inoperable for its intended purpose).

Furthermore, the Applicants respectfully submit that the Examiner mischaracterizes Siwinski. To wit, the Examiner states that Siwinski teaches a non-contact memory being provided on a bag body. (Office Action dated August 29, 2002 at 3.) However, Siwinski fails to teach such.

Siwinski’s teachings show transponders 54a-d (referencing Figures 1 and 2) fixedly connected to hard-bodied ink reservoirs 14a-d. Notably, the present invention defines over Siwinski by teaching a non-contact memory provided on an ink bag body. Comparatively, Siwinski’s teachings reflect rigid, hard-bodied containers. In contrast, the present invention’s independent claims 1, 10, 17 and 21 each reflect a flexible, deformable ink bag body provided with a non-contact memory integrated chip (with each of claims 1, 10, 17 and 21 having individualized nuances of further elements).

Along these lines, the Examiner kindly acknowledges that Childers fails to teach a non-contact memory provided on an ink bag body (Office Action dated August 29, 2002 at 3). As such, because neither Childers nor Siwinski teach a non-contact memory provided on an ink bag body, claims 1, 10, 17 and 21 clearly define over Childers, Siwinski, or any combination of the two.

As to claim 1, claim 1 defines over Childers, Siwinski, or any combination of the two because the references fail to teach a non-contact memory IC provided on a bag body.

As to claims 8 and 9, claims 8 and 9 are patentable at least by virtue of their dependency on claim 1.

As to claim 10, claim 10 is patentable at least for reasons that are similar to the reasons presented above in conjunction with claim 1.

As to claims 11 - 16, such claims are patentable at least by virtue of their dependency on claim 10.

Next, as to claim 17, claim 17 is patentable at least for reasons that are similar to the reasons presented above in conjunction with claim 1.

As to claims 18 and 20, such claims are patentable at least by virtue of their dependency on claim 17.

III. Rejection under 35 U.S.C. § 103(a) over Childers, Siwinski and Yamaguchi

Since claims 2 and 18 depend on claims 1 or 17, and, further, since Yamaguchi does not cure the deficient teachings of Childers and Siwinski with respect to claims 1 and 17, Applicants submit that claims 2 and 18 are patentable at least by virtue of their dependency upon claims 1 or 17.

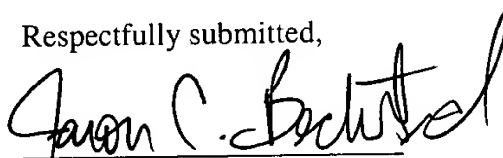
IV. Conclusion

In view of the prior arguments, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

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Respectfully submitted,



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AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. Application No. 09/977,995



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WASHINGTON OFFICE



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PATENT TRADEMARK OFFICE

Date: November 26, 2002



APPENDIX

VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS:

Please enter the following amended claims:

8. (Amended) The ink bag as set forth in claim 1, wherein the memory IC stores data indicating an amount of ink remaining ing [ed] therein.
12. (Amended) The recording apparatus as set forth in claim 10, wherein the memory IC stores data indicating an amount of ink remaining ing [ed] therein.
19. (Amended) The ink bag as set forth in claim 18, wherein the outer peripheral portion of the bag body is formed by heat-welding the outer peripheral portions of flexible sheet members.

Please add new claims 21 - 27.